Remarks/Arguments

Initially, two amendments have been made to present claim 8:

1. in the proviso the phrase "a group RCO, where R is a C7-C21 alkyl or alkenyl" has been removed, since an acyl group was never included within scope of claim 8,

2. applicants have specified that when R^{II} is a group $-CH_2CH_2OH$ then R^{I} is not a group R, where R is a C8-C22 alkyl or alkylene group", which leaves us with compounds having a C23-C24 alkyl group. This amendment essentially disclaims embodiments in the prior art.

3.

Further, typographical errors have been corrected in claim 9.

In the official action mailed March 1, 2010, the examiner imposed a requirement for restriction requiring applicants to elect one of the following inventions for prosecution on the merits.

> **Group I, claims 1- 7**, drawn to a flotation process. (*The office action only indicates claim 7, but applicants believe that the examiner intended Group I to cover claims 1-7. Confirmation is respectfully requested.)*
> **Group II, claims 8 and 9**, drawn to an aspartic acid derivative.
> **Group III, claims 10-11**, drawn to a method to make Group II.

In response to the requirement, applicants hereby elect to prosecute the group I, claims 1-7 on the merits. Applicants hereby traverse the requirement in view of the following.

Since the present case was filed under the Patent Cooperation Treaty ("PCT"), it is clear that 37 C.F.R. § 1.475 governs. Rule 475 sets forth a "unity of invention" standard for restriction practice, which generally means that claimed inventions are linked by a common, single inventive concept. PCT Rule 13.2 specifically defines unity of invention for an international application. It prescribes that unity of invention is met for a group of inventions claimed in an international application when the inventions

involve one or more of the same or corresponding special technical features. It defines a special technical feature as the contribution that each invention makes over the prior art. Thus, unity of invention would exist among the claims in an application describing:

i. a patentable compound,

ii.) a process of making the compound, and

iii.) its method of use.

See Annex B of Appendix A1 of the M.P.E.P. entitled "PCT Administrative Instructions," for additional examples of unity of invention. When examining a PCT originated application having these claims, an examiner must disregard the restriction practice criteria for regular U.S. applications of independence and distinctness in favor of the PCT requirement of unity of invention and examine all the inventions in a single application.

In the present situation, the examiner is respectfully requested to note that some of the compounds used as flotation collectors in the **method** of claims 1-7 are new. The compounds disclosed in JP 05-140059 do not belong to the same technical field as the present invention and therefore it is of limited importance to the patentability of the claimed method. The compounds of claim 8 constitute a subset of the compounds that are defined in claim 1 for use in the flotation method. Additionally, claim 8 is provided with disclaimers to distinguish over known compounds. Accordingly, Group II, claims 8-9 drawn to a compound, i.e., the aspartic acid derivative; Group III, claims 10-11 drawn to the method of making said aspartic acid derivatives; and Group I, claims 1-7 directed to a method of using said derivatives in a flotation process clearly meet the unity of invention under Rule 475.

In view of the foregoing, applicants respectfully request that the examiner reconsider and withdraw the subject restriction requirement and examine all pending claims on the merits.

Should the examiner not withdraw this restriction requirement, he is respectfully requested to clearly articulate his position on the record so that applicants can evaluate the merits of filing a Petition to the Commissioner.

Respectfully submitted,

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